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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1950.

No. 274

AUTOGRAPHIC REGISTER COMPANY,
Petitioner,

vs.

UARCO, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioner, Autographic Register Company, respectfully prays for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit to review the judgment of that court which was entered on the 25th day of May, 1949 (R. 962).

Summary and Short Statement of Matters Involved.

This civil action was brought by Petitioner corporation against Respondent, Uarco, Inc., for infringement upon United States Letters Patent No. 2,082,730, to Brenn granted June 1, 1937 for Manifold Device; No. 2,258,573, to Johnson granted October 7, 1941 for Manifold Pack; and No. 2,212,174 to Brenn granted August 20, 1940 for Manifolding.

The District Court of the United States for the Northern District of Illinois, Eastern Division, filed its opinion (R. 603) following trial, holding the patents in suit invalid, and entered judgment (R. 613) dismissing the complaint and amended complaint "for want of equity and for the reasons set forth" in its opinion.

On appeal of Petitioner, the United States Court of Appeals for the Seventh Circuit affirmed the judgment of the District Court. Its opinion (R. 954) was filed on May 25, 1950. A Petition for Rehearing presented to that Court was denied on June 29, 1950 (R. 963).

Jurisdiction to Review Judgment in Question.

The jurisdiction of this court is invoked under 28 U.S.C. §§1254 and 2101 (C).

Judgment was entered in the Court of Appeals on May 25 and Petition for Rehearing denied June 29, 1950 (R. 963).

The Questions Involved.

Review of the judgment of the Court of Appeals is sought. The following questions are presented.

1. May the Court of Appeals properly and legally hold letters patent to be invalid on the ground that they re-

sult from "the exercise of the skill of the calling" when, in fact, the inventions of such letters patent are of the high standard enunciated by this court, being for inventions which are admittedly novel, of great utility, recognized and adopted by the industry as valuable improvements and which have not been superseded?

2. May the Court of Appeals properly and legally hold inventions of letters patent of a high standard of invention to be "the exercise of the skill of the calling" merely because their devices are simple in construction, in contravention of repeated determinations of this Court, of Courts of Appeals and particularly of the Court of Appeals for the Seventh Circuit?

3. May the Court of Appeals properly and legally construe as an anticipation the patent to Greig No. 2,066,-346, whose application was filed prior to the filing of the application for the Johnson patent No. 2,258,573, but which as filed did not disclose the invention of the Johnson patent in accordance with the requirements of statute (R.S. 4888; 35 U.S.C.A. §33), and was therefore not evidence of prior knowledge or invention (R.S. 4886, 35 U.S.C.A. §31)? The application of Greig was not amended to describe the invention and the article of the Johnson patent until after the application for the Johnson patent was filed and after the article thereof was made and sold.

Reasons Relied Upon for the Allowance of the Writ.

The discretionary power of this court is invoked upon the following grounds:

The determination of the Court of Appeals as to whether or not the inventions of the patents in suit are

for patentable inventions is at variance (a) with the decision of this court in *Goodyear Tire & Rubber Co., Inc. et al.* v. *Ray-O-Vac Co.,* 321 U.S. 275; *Paramount Publix Corp.* v. *American Tri-Ergon Corp.,* 294 U.S. 464, at 474, and (b) with the decisions of Courts of Appeals and particularly of the Court of Appeals for the Seventh Circuit in *Charles Peckat Mfg. Co.* v. *Jacobs,* 178 F. 2d 794 (C.C.A. 7th Circuit); *The Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 179 F. 2d 636 (C.C.A., 6th Circuit); *Ric-Wil Company* v. *E. B. Kaiser Co.,* 179 F. 2d 401 (C.C.A., 7th Circuit); *Patent Royalties Corp. et al.* v. *Land O'Lakes Creameries,* 89 F. 2d 624 (C.C.A. 2nd Circuit).

The determination of the Court of Appeals that the Greig patent No. 2,066,346 is an anticipation of the Johnson patent No. 2,258,573, the application for which was filed prior to the filing of the application for the Johnson patent in suit, but which when filed did not disclose the invention of the Johnson patent in accordance with the requirements of statute (R.S. 4888; 35 U.S.C.A. §33) but which was amended to describe the invention and article of the Johnson patent in suit after the application for the Johnson patent was filed and after the article of the Johnson patent was on the market, is contrary to the decisions of this court in *Alexander Milburn Co.* v. *Davis-Bournonville Co.,* 270 U.S. 390.

The Greig patent could be considered only as to the disclosure of its application when filed—not after it was dressed up by amendment to simulate Johnson.

The divergence of decisions of this court and the Courts of Appeals should be resolved by this court in the interest of the public.

The divergence of decisions of this court and the Courts of Appeals should be resolved by this court in the interest of the public.

Wherefore, it is respectfully submitted that this petition for a writ of certiorari should be granted.

CASPER W. OOMS,
THOMAS J. BYRNE,
Counsel for Petitioners.

Dated: August 22, 1950.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1950.

No.

AUTOGRAPHIC REGISTER COMPANY,
Petitioner,

vs.

UARCO, INC.,
Respondent.

BRIEF IN SUPPORT OF PETITION.

Opinions in the Action.

The decision of the District Court (R. 602) is reported in 86 Fed. Supp. 730, and the opinion of the Court of Appeals (R. 954) is reported in 182 F. 2d 353.

Jurisdiction.

The opinion (R. 954) and the judgment (R. 962) of the Court of Appeals were filed and entered on May 25, 1946. A Petition for Rehearing was filed by petitioner on June 8, 1950 and an order denying the petition for re-

hearing was entered on the 29th day of June, 1950 (R. 963).

The statutes which accord jurisdiction are §1254 and §2101(c) of the New Judicial Code.

Statement of the Case.

The foregoing petition contains a summary of some of the material facts necessary to an understanding of the reasons relied upon for the allowance of the petition. The decision of the Court of Appeals held three patents sued upon to be invalid for want of invention.

The inventions of the patents in suit relate to the manifolding art and particularly to continuous carbon interleaved stationery, that is continuous writing strips, usually in printed forms, interleaved with disposable continuous carbon sheet strips. The leading ends of the strips are introduced into a typewriter or similar writing machine and after each set of forms has been filled out the written set is detached from the continuous strips on weakened dividing lines, and the resulting carbon sheets are separated from the record sheets for the distribution of the latter.

Brenn Patent No. 2,082,730 (R. 630).

This patent solves the special problem of maintaining the separate continuous strips in registration with each other prior to and during the operation of writing upon the record strips. The Brenn patent provides means for holding the strips in registration, so placed and so operative that severing one set of written forms from the strips automatically renders the holding means inoperative. For this purpose, staples, in the Brenn patent, are

placed on the lines of severance between forms so that when one set of forms is detached at the weakened lines from the continuous strips the staple which has previously served the purpose of keeping the strips in alignment automatically drops out, and both it and the severed sheets are freed from each other while the staples between succeeding forms continue to hold the strips in registration until each staple is successively reached in the successive detachment of sets of sheets.

The Court of Appeals admitted that Brenn made "some advancement" but added that he did no more than "might be expected of one skilled in his calling".

The solution of the problem to which Brenn addressed himself was not obvious. It was not obvious to Brenn, and it was not solved by the prior patentees who are mentioned by the Court of Appeals. Prior patentees did not attack the problem which Brenn solved. As the Court of Appeals noted, the prior art did show staples on lines of perforations in sheets in pads, but in no instance in the prior art is there shown a staple or any other means located at intervals along continuous interleaved record and carbon strips which would perform its function of holding the superposed strips in registration until a written set of record and carbon sheets were detached, and then give up its function by the act of severance of the attached sheets freeing the sheets and being itself freed to be discarded. Nor was there any suggestion in the prior art of anything even remotely approaching this successive rendering concept of a combination in which a succession of duplicate sheets are secured together in registration by fastening means which are automatically disabled as to any set of sheets whenever that set is severed from the succeeding sheets.

Brenn's solution of a vexing problem was so simple and convenient, once he hit on the idea, that it was almost immediately adopted by the industry, and is still extensively used in the type of work where it is best suited, namely, where the record sheets are to be distributed immediately upon being detached from the continuous strips.

No claim is made by Brenn for the mere securing of the record and carbon strips together. Obviously that could have been done by stapling them together through the bodies of the forms, but this would require opening and removing the staple before the detached record sheets could be separated or distributed, both to disable the fastening means and to dispose of it. Brenn did the unobvious. He paradoxically placed the staples on the weakened lines between successive forms and discovered that in spite of the suspected insecurity of the staples on the weakened lines, they would perform their functions of holding the strips together and in registration until one by one, as they were reached, they become inoperative in the detachment of successive sets of forms, with which they respectively associated, freed the sheets from each other and were themselves freed for discard.

At the time this action was brought there were eight licensees under this Brenn patent (R. 114). The public was given the benefit of the Brenn invention.

Johnson Patent No. 2,258,573 (R. 636).

The invention of this patent relates to the facility or ease in separating the record sheets from the carbon sheets after a set of sheets has been written upon and detached from the continuous strips. The problem which Johnson solved was to provide simple means for per-

mitting all of the record sheets of a detached set to be simultaneously stripped from all of the carbon sheets and yet be able to maintain the record sheets in their usual rectangular unmutilated form. This was accomplished by so arranging and locating the severance lines marking off the sheet lengths of the carbon strips so that when a set of record sheets and carbon sheets is severed from the continuous strips, portions of the carbon sheets extend at one place beyond the straight edge portions of the superposed record sheets, while other marginal portions of the carbon sheets are inwardly displaced with relation to corresponding marginal portions of the record sheets. These projecting portions form tab areas on the carbon and record sheets respectively which the typist may independently grasp the carbon tab with one hand and the record tab with the other, and merely by separating her hands, effect the separation of the record sheets from the carbon sheets.

In one extensively used form of the Johnson invention, the projections in the carbon are delineated by weakening lines between sheet lengths as tabs in the continuous carbon strips so that the tab-to-be on one carbon sheet extends into and fills the space of a notch-to-be in the next adjacent carbon sheet while the sheets are in continuous form and the embryonic tab first becomes a tab when a written set of records and carbons are detached from the continuous strips.

In this form of Johnson's invention the only structural change is in the shape and location of the weakened line between the carbon sheet lengths and no change is made in the form or severance lines of the record sheets.

The Court of Appeals stated (R. 959) that Johnson was working in a crowded art, but it overlooked altogether the fact that there was only one structure prior to Johnson for facilitating the stripping of a set of detachable record and carbon sheets. This one exception was ultimately described in a patent issued to Bottle, No. 1,736,427, granted November 19, 1929 (R. 776). In this Bottle construction, in order to provide for stripping the carbons from the records, oppositely located corners on the record sheets and on the carbon sheets respectively were cut off, permitting corners of the records to project in one place, and corners of the carbons to project at another place. In another form shown in the Bottle patent, a semi-circular section was removed from the records and carbons, respectively, at opposite ends of the sheet lengths. In each case it was necessary to perform cutting operations on the record sheets and also on the carbon sheets. The record sheets were thus mutilated and could not retain their usual rectangular form.

The problem of stripping the carbon sheets from the record sheets of a detached set of sheets existed from the time when continuous carbon and record strips were first used about 1925 (R. 544).

The problem was seriously attacked beginning in 1926 by Johnson and others associated with petitioner, and their efforts continued for a matter of two years (R. 53) before the solution was hit upon by Johnson in December, 1928. This would clearly indicate that what Johnson (who was admittedly "skilled in the art") accomplished was not obvious, in spite of what may seem obvious after the event. It is true that scattered throughout

the prior art are examples of single sheets having tabs and notches but no one until Johnson discovered how to provide them in a practical manner in continuous forms without special processing or mutilating the record strips.

The stationery embodying the Johnson invention was put on the market by Petitioner in April 1929, and has been continuously used by Petitioner since that time. It is also used by licensees of Petitioner, including the owner of the Bottle patent. The stationery of the Johnson patent has substantially superseded the stationery of the Bottle patent and the latter is now made only on special order (R. 219-220).

The Court of Appeals, as a matter of law, held the Greig patent No. 2,066,346 (R. 844) to be an anticipation of the Johnson invention. The application for the Greig patent was filed in 1926, two years before the filing of the application for the Johnson patent, but the Johnson invention was not disclosed in the Greig application as filed. The drawings of the Greig application illustrate a construction which, if made and used in a way entirely contrary to the theory and mode of operation described in the Greig specification as filed, would tend to approach the idea of the Johnson invention. The original description accompanying the drawing gave no explanation or hint that the construction shown in the drawing could be adapted to produce a finger grip tab on one carbon sheet and a finger grip escape on the adjacent sheet. The drawing and description of the Greig application as it existed prior to the proven date of the Johnson invention, to wit, early December 1928, did not constitute evidence of prior knowledge or invention on the part of Greig. The language of the description of the Greig application as originally filed was so vague and

indefinite with regard to what might be made of the Greig construction, that it amounted merely to prophetic statements, and was not in such "full, clear, concise and exact terms" as is required to establish prior knowledge or invention.

Some months after the stationery of the Johnson patent was placed on the market, the Greig application was amended in an effort to appropriate the inventive ideas of Johnson, and such amendments should have been completely disregarded by the Court of Appeals.

The stationery of the Johnson patent has been in commercial use continuously since 1929 by Petitioner. Competitors have been licensed, at least nine (9) licenses having been granted (R. 115). The public has had the full benefit of the Johnson invention.

Brenn Patent No. 2,212,174 (R. 930).

This patent is directed to the problem of providing in continuous form, sets of record and carbon sheets secured together in sets, so that the records and carbons comprising one set are held together in registration prior to, during and after the writing operation, and remain held together after the detachment of a set from the continuous strips. Thus, the detached, secured-together set will remain in registration for writing operations subsequently to be performed. This Brenn did by providing on the record strips a feeding band, in which the securing means is located, separated from the main body of the record strip by a weakening line. The feeding band constitutes a binding stub to hold the detached record and carbon sheets together. To facilitate stripping of the record sheets from the carbon sheets the records project

beyond the carbon strips at the side of the pile opposite the feeding band, and the carbons project into the feeding band and are there unweakened. Thus, when the typist, after a set of record sheets and attached carbons is separated from the strip, grasps the feeding band and projecting carbon strips with the fingers of one hand and the oppositely projecting strips with the fingers of the other hand and jerks the hands apart, the carbon sheets and feeding band come away in one hand while the record sheets in their usual rectangular form come away in the other hand.

The Court of Appeals in its interpretation of the Phillips and Allan patent No. 2,306,900 (R. 940) stated that it employs continuous record strips, interleaved with carbon strips, secured to a carrier belt by stitching (R. 959). No such arrangement is involved in the Brenn patent No. 2,212,174. The problem of Phillips and Allan was entirely different from that of Brenn. In Phillips and Allan, when the set of written forms are torn along the line 14 all of the strips are not held in registration by any fastening means for convenient reentry of further data on the detached set of forms. The Phillips and Allan patent does not disclose any means for facilitating the stripping of the carbon sheets of a separate set from the records. The Court of Appeals mentioned that Brenn lost an interference to Phillips and Allan (R. 959), but this interference did not involve the Brenn patent No. 2,212,174 in suit. It involved merely the provision of a backing strip which is not disclosed or covered by the patent in suit. The fact of the matter is that Phillips and Allan lost an interference to Brenn on the issue of providing the fastening means on the weakened line between forms (R. 504-513), the claims in issue being contained in Brenn patent No. 2,082,730 in suit.

The Brown patent No. 1,738,633 (R. 786) discloses continuous record strips secured together at a marginal edge to remain together as a booklet of sheets when detached, but the patent is entirely silent on what disposition is made of the carbon sheets and Brenn's teaching of having the carbon sheets caught in the binding margin on one side and the record sheets projecting beyond the carbons at the other side is entirely lacking in this patent.

Stevens patent No. 2,120,161 (R. 896) discloses a single set of record and carbon sheets arranged so that the carbon sheets and record sheets can be stripped from each other but no disclosure is included in the Stevens patent and apparently it was not obvious to anyone, until Brenn did it, how the Stevens construction could be made available in continuous form stationery. In this Stevens patent the binding edge extends across the form at the top and it does not constitute in any manner a feeding band. In the Brenn patent in suit No. 2,212,174 the binding margin extends vertically, i.e. longitudinally of the strips. It performs the double function of a feeding band to cause the strips to feed continuously while maintaining registration and of a binding stub for the record and carbon sheets after a set is detached from the continuous strips.

Other examples of facilities for stripping records and carbons in single sets of sheets, as distinguished from continuous strips, were well known in the art but none of these suggested to those skilled in the art the possibility of use with continuous strips.

The article of the invention of Brenn patent No. 2,212,-174 has been sold extensively by petitioner. At least seven (7) licenses under it have been granted by Petitioner

(R. 115). The public was afforded the benefit of the article of this Brenn patent.

The devices of the patents in suit are simple in construction but this does not negative invention.

The structures involved in the patents in suit and in the devices charged to be infringed are extremely simple and the changes viewed in retrospect may seem slight. Nevertheless it should be borne in mind, and as to this the Court of Appeals apparently failed, that the opportunity for change was extremely limited. All that the patentees had to work with were pieces of paper and fastening means. There were no mechanical parts or movements to be modified as in the case of machines. Any change that would be practical, considering the large numbers of devices in use, and the very small unit cost thereof, would necessarily have to be extremely simple both to make and to use.

In *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U.S. 275, this court had before it a situation very similar to that in the case at bar. With respect thereto it said (page 279):

> "Viewed after the event, the means Anthony adopted seemed simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention."

In *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, this Court said (p. 435):

> "Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention."

Specification of Errors.

The Court of Appeals erred in that it held the patents in suit to be invalid, in that it did not hold that the invention of each of the patents in suit is of the high standard of novelty required by this court, and in that it did not hold that the inventions of the patents in suit are valid.

The court erred in that it held that the inventions of the patents in suit are the exercise of the skill of the calling, and in that it did not hold that the inventions of the patents in suit are of a high standard of invention and that they are for meritorious inventions.

The Court of Appeals erred in that it held that the Greig patent No. 2,066,346 disclosed and anticipated the invention of the Johnson patent in suit, and in that it did not hold that the Greig patent does not disclose the invention of and does not anticipate the invention of the Johnson patent in suit.

ARGUMENT.

Point I.

The decision of the Court of Appeals (R. 954) is in conflict with the decisions of this court and with decisions of the United States Courts of Appeals on the issue of invention as to the patents in suit.

The inventions of the patents in suit are of the high standard required by this court. See *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84. The Court of Appeals determined that they are the mere skill of the calling and in this the Court of Appeals is demonstrated to be in error by the history of this art. Those having the skill of the calling did not produce the inventions of the patents in suit when they were needed. The art had to wait until the inventors Brenn and Johnson created the articles of the patents in suit. If the structures of the patents in suit were the result of mere skill of those skilled in this art the inventions would have been produced in the normal course of events when the need arose.

The inventions are so simple in construction that it is hardly conceivable that they could be produced by laborious effort. They could only result from continuous and persistent seeking, and the exceptional perception of the inventor.

In the *Ray-O-Vac* case, *supra* (p. 17), the extremely small physical change required produced a very important improvement. It involved the mere enclosing of a conventional flashlight battery in a steel shell to prevent

leakage of the electrolyte from the unit. Extensive use was made of the invention as in the case at bar. Nevertheless in that case this court determined that what the patentee did evidenced patentable invention and not the mere skill of the calling.

See also *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 495-6; *Magowan* v. *New York Belting Co.*, 141 U.S. 332, 343; *Topliff* v. *Topliff*, 145 U.S. 156, 163, 164; *Keystone Mfg. Co.* v. *Adams*, 151 U.S. 139, 143; *Potts* v. *Creager*, 155 U.S. 597, 609; *Minerals Separation, Ltd.* v. *Hyde*, 242 U.S. 261, 270; *Smith* v. *Snow*, 294 U.S. 1, 7, 14; *Paramount Publix Corp.* v. *Tri-Ergon Corp.*, 294 U.S. 464, 474.

Point II.

Merely because a device of a patent is simple of construction and easily understood does not negative invention. It was pointed out above that the invention of each of the patents in suit is of the high standard enunciated by this court and that the invention of each of the patents in suit is of simple and readily understood construction—once disclosed. The simplicity of an article of a patent does not negative invention therein.

In the *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275, this Court said (page 279):

> "Viewed after the event, the means Anthony adopted seemed simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention."

See also *Loom Company* v. *Higgins*, 105 U.S. 580, 589, 591; *The Barbed Wire Patent*, 143 U. S. 275, 277, 283; *Krementz* v. *S. Cottle Co.*, 148 U. S. 556; *Expanded Metal Co.* v. *Bradford*, 214 U.S. 366, 381; *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U.S. 428, 434-435.

The decision of the Court of Appeals for the Seventh Circuit in the case at bar is contrary to numerous of its decisions in other cases. For example, in *Charles Peckat Mfg. Co.* v. *Jacobs*, 178 F. 2d 794 (decided December 12, 1949) a very simple clamp for an automobile visor was involved. It was held valid notwithstanding the fact that wedge clamps and their functions are well known in the arts. In its opinion the Court of Appeals for the Seventh Circuit said (page 801, first column):

> "that Peckat's device now seems comparatively simple, of course, is no criterion of his invention."

See also *Ric-Wil Company* v. *E. B. Kaiser Co.*, 179 F. 2d 401 (C.C.A. 7th Circuit).

Of like purport are decisions, with regard to simple inventions, of Court of Appeals of other circuits, to wit:

Patent Royalties Corp. et al. v. *Land O'Lakes Creameries, Inc., et al*, 89 F. 2d 624 (C.C.A. 2nd Circuit), involved merely the provision of truncated cones in the "flats" of egg crates.

The Great Atlantic and Pacific Tea Co. v. *Supermarket Equipment Corp.*, 179 F. 2nd 636, (C.C.A. 6th Circuit), involved a three-sided bottomless frame for use on checking-out counters of chain stores.

In *Brown and Sharpe Mfg. Co.* v. *Kar Engineering Co.*, 154 F. 2d 48, the Court of Appeals for the First Circuit found patentable invention in the provision of a simple magnetic chuck.

Point III.

The Court of Appeals determined that the patent to Greig No. 2,066,346 anticipated the Johnson patent in suit

No. 2,258,573. The application for the Greig patent (which was filed prior to the application of the Johnson patent) as filed does not disclose the Johnson invention. After the application for the Johnson patent was filed and the article of the Johnson patent was upon the market, the application for the Greig patent was amended to describe the invention of the Johnson patent.

The only defense available with respect to Greig is that of prior knowledge or prior invention as evidenced by Greig's application *as filed* and as it existed prior to the time that Johnson made his invention. The fact is that amendment was not made in the application for the Greig patent until after the application for the Johnson patent was filed and the article of the Johnson patent was in public use and on sale in the United States. The lack of applicability of the prior "knowledge" or "invention" by Greig is disposed of by the decision of this court in *Alexander Milburn Company* v. *Davis-Bournonville Co.*, 270 U.S. 390, which was brought for infringement of a patent to one Whitford for welding and cutting apparatus.

In the *Milburn* case the application of Clifford contained "a complete and adequate description". In the case at bar there was no doubt that the application of Greig is filed and as it existed until after Johnson filed his application and after the article of the Johnson patent was on the market *did not* contain a "complete and adequate description" of the article patented to Johnson. The Court of Appeals was wrong in its interpretation of the Greig patent and its application. Its determination is contrary to the decision of this court in the *Milburn* case. The Court of Appeals was required to construe the description of the Greig patent as filed

the same as it would have been obliged to construe a publication or other evidence of prior knowledge or prior invention. It did not do so and made grievous error.

In *Western States Mach. Co.* v. *S. S. Hepworth Co.*, 147 F. 2d 345, the Court of Appeals for the Second Circuit had before it an appeal in a patent suit relating to the extraction of sugar from molasses. The doctrine of the *Milburn* case was considered in connection with one of the patents. The Court of Appeals stated (p. 348, 2nd column):

> "* * * no application will serve to invalidate the later invention except one that contains in its disclosure all that is in the later application."

The Court of Appeals in the *Western States* case merely stated the rule with respect to the defense of prior invention.

In *Coffin* v. *Ogden*, 18 Wallace 120, this Court stated the rule governing the defense of prior invention as follows (p. 124):

> "The invention or discovery relied upon as a defense, must have been complete, and capable of producing the result sought to be accomplished; and this must be shown by the defendant. * * * If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility."

The application of Greig is not a reference to the Johnson patent in suit.

Conclusion.

It is submitted that the petition for writ of certiorari should be granted.

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THOMAS J. BYRNE,
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SEP 11 1950

IN THE

Supreme Court of the United States

OCTOBER TERM 1950.

No. 274

AUTOGRAPHIC REGISTER COMPANY,

Petitioner,

vs.

UARCO INCORPORATED,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

OPINIONS BELOW.

The decision of the District Court (R. 602) holding all of the patents in suit were invalid for lack of patentable invention is reported in 86 F. Supp. 730; and the opinion of the Court of Appeals for the Seventh Circuit (R. 954), affirming the judgment and finding the patents invalid for want of patentable invention over the prior art is reported in 182 F. 2d. 353. There are no conflicting decisions, and no decision sustaining any of the patents.

JURISDICTION.

The jurisdictional requisites are adequately presented in the petition.

QUESTIONS PRESENTED.

Petitioner has propounded three questions that do not properly arise under the facts appearing in the record. The questions concern the right of the Court of Appeals to "properly and legally" hold the patents invalid for lack of patentable invention.

1. The first question is bottomed on alleged commercial success, but Plaintiff's proposed exhibits to indicate commerial success were not admitted in evidence (R. 168-171) and petitioner did not urge or point out any errors in the ruling.

2. The second question assumes that the patents were held invalid merely because the devices are simple in construction. The Court of Appeals did not mention the simplicity of the structures. The patents were held to lack invention over the prior art discussed in the opinion.

3. The last question concerns whether the Greig patent was a proper reference because it was amended during its prosecution. The teachings of this patent, relied upon as an anticipation, were in the Greig application as originally filed, and that date of filing was admittedly long prior to the alleged invention of Johnson.

STATEMENT OF THE CASE.

In the District Court, petitioner sued on four patents, but after all four were held invalid for lack of invention it appealed on only three. None of the patents discloses any invention, but each claims the most trivial variations in continuous-form stationery which were made by various

competitors as soon as the need arose. When continuous-form stationery became popular in the middle twenties, due to the increasing cost of office help, a flood of patents resulted.

Respondent developed its accused stationery and marketed it long before it knew of petitioner's work or attempt to obtain the patents in suit. Petitioner kept all of the patents pending in the Patent Office, from nine years and nine months for the first Brenn patent to twelve years and eight months for the Johnson patent. During this period respondent's stationery, and that of other competitors, was being popularized and going into wide use.

BRENN PATENT 2,082,730 (R. 630).

Petitioner found that it could avoid infringement of Brown patent (R. 766), which claimed separate strips of stationery, by stapling the strips together. It then obtained the patent in suit by specifying that the staple was on the line of weakening. As pointed out in the decision of the Court of Appeals, the prior art shows that it was old to staple strips together on the line of weakening between forms. The Court concluded that Brenn "did no more than might be expected of one skilled in his calling."

JOHNSON PATENT 2,258,573 (R. 636).

The structure of the Johnson patent was admittedly devised to avoid the notched corner construction shown in Bottle Patent 1,736,427. The prior art shows that it was old to insert sheets of paper in a typewriter with the carbon sheets offset so as to facilitate their separation after typing is completed. Johnson did the same thing in continuous-form stationery. The Court of Appeals pointed out that Bottle and others had suggested various means to facilitate ease of separation. The Court said (R. 959)

> "With this evidence before us, supplemented by the testimony of witnesses, the District Court found that Johnson had not achieved invention. We think the record is such that we are without right to set aside this finding. Rather, we agree that Johnson, working in a crowded art, merely adopted the expedient of one skilled in the calling of assembling and disassembling multiple sheets consisting of work sheets and carbon sheets. * * * We think that the adoption of any one of these methods was the choice of the worker and did not arise to the dignity of patentable invention."

That the conclusion of both of the lower courts is correct is further supportedby the record which shows that fourteen other people, independently, confronted with the same problem, solved it at about the same time, as soon as the need appeared. It is difficult to imagine more compelling evidence that the Johnson structure was obvious to those skilled in the art. In view of the findings, the Court did not find it necessary to pass on the further defense that the Johnson patent application was broadened during its prosecution to cover subsequent developments of others.

BRENN PATENT 2,212,174 (R. 930).

This patent discloses and the claims in suit specify that the work sheet strips are provided at one of the lateral edges with a feeding band. The patent makes it clear that the "feeding band" has regularly spaced holes so that the stationery may be fed around the platen of a typewriter by means of a pin wheel. The accused stationery does not have a feeding band.

Phillips and Allen Patent 2,306,900 (R. 940) shows continuous-form stationery secured to a carrier belt provided with feed holes. In Fig. 2, the "feeding bands" are detachable along a line of weakening. Brenn lost an interference

with these inventors, (Defendant's Exhibit D-16, pages 32, 48).

Phillips and Allen 2,149,544 (R. 916) shows continuous-form stationery with interleaved carbon held by a lateral binding strip, and Brown Patent 1,738,863 (R. 786) shows continuous-form stationery attached at one side by a detachable binding strip similar to respondent's.

Brenn also lost an interference with Stevens, (Defendant's Exhibit D-16, page 46) but Brenn then obtained a patent by claiming Stevens' sets in continuous strips.

The Court of Appeals concluded that Brenn, working in a crowded field, made the kind of a suggestion that would occur to any typist who took the time to think about the problem. The Court said,

> "At any rate, the evidence is such, consisting not only of documentary evidence but also of parol testimony, that we conclude that we would be wholly unjustified in setting aside the finding of invalidity."

FINDINGS OF NO INVENTION.

Both the Court of Appeals and the District Court made a careful examination of the patents in suit with the prior art and found that no patentable invention was involved. The District Court considered various interrogatories and answers, heard considerable testimony by experts in open court, and examined the voluminous file wrapper of the Johnson patent and commented on it at length. The District Court said:

> "I believe, and therefore find as a fact, that none of the alleged patents in suit are inventions, but at the most improvements in technique or mechanical skill and are, therefore, void.

The Court of Appeals in its decision, after discussing the patents in suit and much of the pertinent art, concluded:

> "After consideration of the entire record we are of the opinion that all three of these patents reflect not patentable invention but merely the exercise of the skill of the calling and an advancement plainly in accord with the prior art, within the decision of the Supreme Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 62 S. Ct. 37, 39, 86 L. Ed. 58".

This Court said in *The Goodyear Tire & Rubber Company, Inc., and General Dry Batteries, Inc.* v. *Ray-O-Vac Company,* 321 U. S. 276:

> "It must be a strong case in which this Court will set aside these concurring findings of two courts."

See also *Williams Mfg. Co.* v. *United Shoe Machinery Co.*, 316 U. S. 364, 367.

CONCLUSION.

As petitioner has failed to point out any manifest error which should cause this Court to exercise its discretionary power, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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SCHROEDER, MERRIAM, HOFGREN & BRADY,
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September 7, 1950.